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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/398,229	09/17/1999	JONATHAN J. HULL	74451.P100	9798

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EXAMINER

FLYNN, KIMBERLY D

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 08/13/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/398,229

Applicant(s)

HULL ET AL.

Examiner

Kimberly D Flynn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, and 3-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, and 3-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to an Amendment and request for reconsideration filed July 29, 2003. Claims 1, and 3-28 are presented for further consideration.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 14, 17, 22, and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- The specification does not describe a “subset of electronic documents” nor does it describe means for carrying out the functions of acquiring or creating a subset of documents. The specification also does not describe distinguishing the “subset” of documents” to be published from the documents not included in the subset that are not to be published.
- Claims 2-13, 15-16, 18-21, and 23-27, which depend from the previously rejected claims 1, 14, 17, 22, and 28, are rejected for the same reasons stated above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1, 3-4, 11-17, 22, and 27-28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (U.S. Patent No. 5,848,413 hereinafter, Wolff) in view of Hull (U.S. Patent No. 5,978,477 hereinafter, Hull) in further view of Bauer (U.S. Patent No. 6,188,673 hereinafter Bauer).

In considering claims 1, 14, 17, 22, and 28, Wolff discloses a system for publishing electronic documents on a network (*see. Fig 7*) comprising:

a multifunction machine to supply multiple electronic documents (*col. 7, lines 29-30*);

While Wolff discloses a multifunction machine for use in publishing documents on the Web, Wolff does not explicitly disclose wherein the multifunction machine saves the electronic documents in the absence of an explicit command by a user to save the electronic documents and in response to another user specified function associated with the electronic documents.

Nonetheless, multifunction machines that performs user specified functions as wells as saving documents in the absence of an explicit command are well known as evidenced by Hull.

In similar art Hull discloses a fax machine wherein the depression of the start button at the appropriate time represents a single user command to both fax and archive (save) a

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documents without further user input (*See Hull col. 6, 49-52 and col. 7, lines 11-12*). It would have been obvious to a person having ordinary skill in the art to modify the system as disclosed by Wolff to include the automatic archiving feature so that documents could be stored and filed without user intervention thereby reducing time, costs, and error while providing for future search and retrieval of the documents. Therefore, the aforementioned limitations as they appear in claims 1, 14, 17, 22, and 28, above would have been obvious from the explicit teachings of Hull.

While Wolff discloses a gateway server parsing and creating a document for publication over a network (*See Wolff col. 7, lines 40-49*), Wolff does not explicitly disclose wherein the documents published are included in a subset and wherein the documents not included in the subset are not published with the subset of electronic documents. Nonetheless, the uses and advantages of including the documents in a subset wherein the documents not to be published are not included in the subset would have been obvious to a person having ordinary skill in the art at the time the invention was made. The user as disclosed by Wolff, faxes hard copy documents to the gateway server wherein the gateway server then creates an HTML document to be published over the network. The user essentially creates a subset of documents because the user faxes documents that the user intends to be published. Accordingly, the aforementioned limitations would have been an obvious modification to the system as disclosed by Wolff.

a server coupled to the filter, the server having a memory to store the electronic documents, the server to publish the subset of electronic documents by selectively permitting access to the subset of electronic documents. (*See Wolff col. 7, line 50-67 through col. 8, line 3*).

In considering claim 3, Wolff further discloses wherein the multifunction machine comprises a print driver that selectively publishes one or more electronic documents on a network (*See Wolff col. 3, lines 35-37*).

In considering claim 4, Wolff further discloses wherein the filter provides one or more authorized users with a Universal Resource Locator (URL) corresponding to a published electronic document (*See Wolff col. 7, lines 55-60*).

In considering claim 15, Wolff further discloses wherein sending the electronic documents comprise a multi-function machine printing the electronic documents (*See Wolff col. 7, lines 29-39*).

In considering claims 16 and 27, although the system taught by Wolff discloses substantial features of the claimed invention it fails to disclose wherein the server generates a security key. However Wolff does disclose wherein the server allows access to the documents by creating an identifier/locator for the documents. Thus, a person having ordinary skill in the art would have recognized the desirability generating a security key as well as an identifier so that the server would not only allow access to the documents, but also authorized access to the documents. Therefore, the claimed limitation would have been an obvious modification to the system taught by Wolff.

In considering claims 18 and 23, Wolff disclose a system further comprising the server automatically notifying a user that an electronic mail message containing a Universal Resource Locator (URL) has been sent from the server (*See Wolff col. 7, lines 55-62*).

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5. Claims 8-13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (U.S. Patent No. 5,848,413 hereinafter, Wolff) in view of Hull (U.S. Patent No. 5,978,477 hereinafter, Hull) in further view of Bauer.

In considering claims 8, while the combined system of Wolff and Hull discloses the system substantially as claimed, it does not disclose wherein the server maintains access logs and updates the access logs each time a published electronic document is accessed. Nonetheless, servers that maintain access logs for documents or WebPages and updates the log each time it is accessed are well known as evidenced by Bauer. In similar art, Bauer discloses a system associated with a World Wide Web site whose pages provide a call request capability wherein a call center receives notifications of page hits and requests from the Web server. Bauer also discloses wherein the data is stored for later use or to generate reports on historical ratios of the number of hits (*See Bauer, abstract and col. 5, lines 46-48*).

It would have been obvious to a person having ordinary skill in the art to modify the system as disclosed by Wolff to include the access log feature in order to maintain historical data and to use it to predict future traffic. Therefore, the aforementioned limitations as they appear in claim 8 above, would have been obvious from the explicit teachings of Wolff and Hull.

In considering claims 9-10, Bauer further discloses a server comprising a system manager that is capable of accessing the access logs (*See Bauer, col. 5, lines 37-44*).

In considering claims 11-12, Bauer further discloses wherein the system manager notifies the publisher automatically, by sending an electronic mail message to the publisher in response to the electronic documents being accessed by a user (*See Bauer, col. 4, lines 62-67*).

In considering claim 13, while the combined system of Wolff, Hull and Bauer discloses the system substantially as claimed, it does not disclose the step of performing virus removal. However, examiner takes official notice that performing virus removal is notoriously well known in the art. A person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying the filter to include the virus removal feature in order to eliminate any harmful programs from destroying the created web page. Therefore, the aforementioned limitations as they appear in claim 13 above, would have been an obvious modification.

6. Claims 5-7, 19-21, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff in view of Hull in further view of Skarbo et al. (U.S. Patent No. 6,317,777 hereinafter, Skarbo).

In considering claim 5-7, 19-21, and 24-26, although the combined system of Wolff and Bauer discloses substantial features of the claimed invention, it fails to disclose wherein the server deletes or prevents access to the documents based on certain conditions. The conditions being when an authorized user accesses the documents after the documents has been stored on the server for a predetermined amount of time, or if the documents had been accessed a predetermined number of times. Nonetheless, the auto-deletion of documents based on certain conditions is well known as evidenced by Skarbo. In similar art, Skarbo discloses a system and method for web based storage and retrieval of documents wherein administrative options may be set pertaining to documents such as the auto-deletion after n days, displaying user access rates, and resources used (*col. 7, lines 9-18*).

Thus given the teachings of Skarbo a person having ordinary skill in the art would have recognized the desirability to modify the combined system of Wolff and Bauer to include the maintenance options, described above, so that the publisher of the documents would have control over the documents' accessibility. Therefore, the claimed limitations would have been obvious modifications to the combined system of Wolff and Bauer.

Response to Arguments

7. In response to Applicant's remarks filed on July 29, 2003, the following factual arguments are noted:

a. Neither Hull nor Wolff discloses the publication of a subset of captured electronic documents. While Wolff discloses a gateway server parsing and creating a document for publication over a network (*See Wolff col. 7, lines 40-49*), Wolff does not explicitly disclose wherein the documents published are included in a subset and wherein the documents not included in the subset are not published with the subset of electronic documents.

Nonetheless, the uses and advantages of including the documents in a subset wherein the documents not to be published are not included in the subset would have been obvious to a person having ordinary skill in the art at the time the invention was made. The user as disclosed by Wolff, faxes hard copy documents to the gateway server wherein the gateway server then creates an HTML document to be published over the network. The user essentially creates a subset of documents because the user faxes documents that the user intends to be published. Accordingly, the aforementioned limitations would have been an obvious modification to the system as disclosed by Wolff.

b. The applicant also contends that neither Hull nor Wolff provides selective access to the published documents that are saved without an explicit user command. Examiner disagrees. Wolff discloses a system comprising a gateway server that after receiving, creating, and storing documents, the gateway server services requests for that document from Web clients (See Wolff col. 7, lines 63-67).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D Flynn whose telephone number is 703-308-7609. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Kimberly D Flynn
Examiner
Art Unit 2153

KF
August 7, 2003


KRISHNA LIM
PRIMARY EXAMINER